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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/659,027	09/11/2003	Kia Silverbrook	NPP29US	4221

24011 7590 12/14/2005

SILVERBROOK RESEARCH PTY LTD  
393 DARLING STREET  
BALMAIN, NSW 2041  
AUSTRALIA

EXAMINER
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YAN, REN LUO

ART UNIT	PAPER NUMBER
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2854

DATE MAILED: 12/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/659,027

Applicant(s)

SILVERBROOK ET AL.

Examiner

Ren L. Yan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>9/11/03/2/4/05</u> .  | 6) <input type="checkbox"/> Other: _____                                    |

### DETAILED ACTION

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,669,385. Although the conflicting claims are not identical, they are not patentably distinct from each other because the structure of a printing and binding device as recited in claims 1-3 of the present application has been taught by claim 1 of the US patent and claims 1-3 of the present application are broader versions of the same invention as claimed in the patent.

Claim 8 is rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,669,385 in view of Morgavi(5,558,449). Claim 1 of the patent teaches all that is claimed except for the use of two opposing printheads to simultaneously print on both sides of the media sheets as the media sheet passes between the two printheads. Morgavi teaches the conventionality of using two printheads disposed opposite to

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each other so as to enable simultaneous printing on both sides of a sheet passing between the two printheads. In view of the teaching of Morgavi, it would have been obvious to those having ordinary skill in the art to provide the printing device of the US patent with the opposing printheads as taught by Morgavi in order to simultaneously print on both sides of the sheet passing thereby and eliminate the cost of a sheet reversing mechanism when only one printhead is used.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami(5,601,389) in view of Kukucka et al(4,603,971).

With respect to claims 1-3, the patent to Minami teaches a book printing and binding device as claimed including a media tray 10 to receive and retain a plurality of media sheets, an adhesive applicator 8 adapted to apply adhesive to the printed media sheets, a binder adapted to bind the plurality of printed media sheets together, where the device is adapted to print and bind the media sheets in an original plane of orientation in the media tray by transporting each of the media sheets from the media tray, past the adhesive applicator, to the binder, whilst substantially maintaining the media sheets in its original plane of orientation and in a substantially straight line. See Figs. 1-3 and column 3, line 60 through column 4, line 26 in Minami for details. Minami also discusses in column 4, lines 32-43 the use of a printer operatively connected with a computer in accordance with the invention of the patent so that books having different contents,

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number of pages and the like can be printed and bound efficiently and correctly. However, Minami does not show the structure of the printer and does not show an overall housing that contains the media tray, the printhead, the adhesive applicator and the binder. Kukucka et al teach an inline printing and binding device including a media tray 35, a printhead section 10, an adhesive applicator 67 for applying adhesive to the printed media sheets, a binder for binding the plurality of printed media sheets together. Kukucka et al also teach an overall housing for containing the media tray, the printhead, the adhesive applicator and the binder. See Figs. 1-5 and column 6, lines 8-14 in Kukucka et al for example. In view of the teaching of Kukucka et al, it would have been obvious to those having ordinary skill in the art to provide the printing and binding device of Minami with the printing mechanism appropriately disposed in between the media tray and the adhesive applicator so as to carry out the book printing and binding operation in one continuous media sheets transport path and with an overall housing structure containing the media tray, the printing mechanism, the adhesive applicator and the binder in order to prolong the service life of these working components since they are not exposed to the external environment.

With respect to claims 4 and 6, since none of the media tray and the binder has been defined to have any particular shape or structural requirement, the recited orientation of the media tray and the binder is inherently met by the teachings of the applied prior art.

With respect to claims 5 and 7, since the media sheet being processed has not been defined to be of any particular size and the printing and binding device of the applied prior art is capable of handling different sized media sheets, it would appear to those having ordinary skill in the art that depending on the size of the media sheets, the relationship between the length of the

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housing and the length of the sheet changes every time a different size sheet is loaded into the device. Accordingly, it is believed that the recited size relationship between the housing and the sheet would be met when a particular size sheet is loaded into the device.

With respect to claim 10, since there is no structure being defined to mount the device onto a wall, the printing and binding device of the applied prior art is certainly "wall-mountable" as recited.

Claims 8 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Minami in view of Kukucka et al as applied to claim 1 above, and further in view of Morgavi(5,558,449).

With respect to claim 8, Minami, as modified by Kukucka et al teaches all that is claimed except for the use of two opposing printheads to simultaneously print on both sides of the media sheet. Morgavi teaches a printing machine that use two opposing printheads 10 and 11 to simultaneously print on both sides of a media sheet 33 that passes between the two printheads. See Fig. 1 and the last paragraph of column 2 in Morgavi for example. It would have been obvious to one of ordinary skill in the art to provide the printing and binding device of Minami, as modified by Kukucka et al with two printheads disposed opposed to each other in order to enable simultaneous double side printing on a passing sheet so as to increase the efficiency of the printing and binding device.

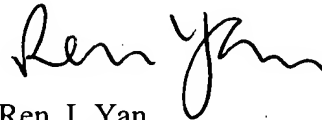
With respect to claim 9, the printing device of the applied prior art does not state how many sheets the printer can print per minute. However, the printing speed of the printer is determined by one of ordinary skill in the art during the design phase based on the desired printing output through routine experimentations. Such a routine experimentation carried out by those having ordinary skill in the art would have been most obvious.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ren L. Yan whose telephone number is 571-272-2173. The examiner can normally be reached on 8:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Hirshfeld can be reached on 571-272-2168. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ren L Yan  
Primary Examiner  
Art Unit 2854

Ren Yan  
Dec. 9, 2005